

## REMARKS

This reply is responsive to the Office Action mailed Jun 15, 2005. Upon entry of this amendment, claims 1-4 are pending. No new matter has been added, and the application is believed to be in condition for allowance. Reconsideration of the application is respectfully requested.

In the Office Action mailed June 15, 2005, the examiner:

- rejected claim 1 under 35 U.S.C. § 101 as not limited to being embodied in a tangible medium;
- rejected claims 1-4 under 35 U.S.C. § 103(a) as being unpatentable over Akihiro (JP 11-347250) in view of Kazuhiko (JP 2002-253848) and Subsim Review (Silent hunter II and destroyer command);

### Rejection Under 35 U.S.C. § 101

Claim 1 stands rejected under 35 U.S.C. § 101 because it is directed to game software that is not limited to embodiment in a tangible medium. The examiner suggested that the claim be amended to insert language stating that the game software is embodied in a computer readable medium. Claim 1 has been amended to incorporate the examiner's suggestion, and thus applicants request that the 35 U.S.C. § 101 rejection of the claim be withdrawn, and that claim 1 be allowed.

### Rejections Under 35 U.S.C. § 103(a)

Claims 1-4 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Akihiro in view of Kazuhiko and Subsim Review. Applicant traverses.

Independent claim 1 recites, *inter alia*,

"a process for removing said invisible item from said position for obtaining when being instructed to obtain said item through said controller in such a state that said distance computed with said process for computing item distance becomes a predetermined value or lower;  
a process for stopping output of said predetermined sound from said sound output means when instructed to obtain said item through said controller...."

Independent claim 4 recites, *inter alia*,

" means for removing said invisible item from said position for obtaining when instructed to obtain said item through said controller in such a state that a distance computed with said means for computing item distance becomes a predetermined value or lower;  
means for stopping output of said predetermined sound from said sound output means when instructed to obtain said item by said controller ...."

Independent claims 1 and 4 are patentable over Akihiro, Kazuhiko, and Submsim Review because these references, whether considered alone or in any routine combination, fail to disclose, teach or suggest all of the limitations of claim 1 or 4. Specifically, the cited references fail to disclose, teach or suggest:

"removing said invisible item from said position for obtaining when [] instructed to obtain said item through said controller in such a state that said distance computed with said process for computing item distance becomes a predetermined value or lower; [and] ... stopping output of said predetermined sound ... when instructed to obtain said item [through/by] said controller..."

These limitations are particularly and distinctly defined in claims 1 and 4 and are not met by the cited references.

None of the prior art rereference of record, either alone or in any routine combination, discloses, teaches or suggests a process or means for "removing [an] invisible item from [a] position for obtaining when instructed to obtain said item ...," nor a process or means for "stopping output of ... sound ... from [a] sound output means when instructed to obtain said item by said controller."

The examiner has conceded that Akihiro does not disclose removing the invisible item and stopping sound output when an invisible item is obtained. (See Detailed Action, page 3, lines 8-10.) Kazuhiko does not remedy this deficiency, but rather discloses updating a player character image to show a face of the character turned to an object. (See Kazuhiko reference, Solution section, lines 7-13).

Subsim Review does not remedy the deficiencies in Akihiro and Kazuhiko or their combination. The examiner cites pages 5-6 of Subsim Review, stating that it “discloses removing the obtained object and allowing the player to start or stop the output sound.” (See Detailed Action, pg. 3, line 16 – pg. 4, line 1.) Applicant finds no objective disclosure on these pages that would fairly support the examiner’s contention. Such disclosure also is not inherent in Subsim Review because the mere fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. See *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993) (reversing rejection because inherency was based on what would result due to optimization of conditions, not what was necessarily present in the prior art). Further, “[i]n relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art.” *Ex part Levy*, 17 U.S.P.Q.2d 1461, 1464 (Bd. Pat. App. & Inter. 1990) (emphasis in original). Subsim Review, at pages 5 and 6, merely discloses that after a ship is killed, the players can return to a multiplay waiting room to play another round. See Subsim Review, pgs. 5-6.

Thus, none of the cited references discloses “removing said invisible item from said position for obtaining when [] instructed to obtain said item through said controller in such a state that said distance computed with said process for computing item distance becomes a predetermined value or lower; [and] ... stopping output of said predetermined sound ... when instructed to obtain said item [through/by] said controller...,” as required by claims 1 and 4.

Furthermore, applicant disagrees with the examiner’s posited motivation to combine Akihiro, Kazuhiko and Subsim to achieve the invention of claims 1-4. The examiner states that

“[i]t would have been obvious to a person of ordinary skill in the art at the time the invention was made to replace the object of Akihiro with the invisible item of Kazuhiko, and to remove the object that is obtained by the player character and to stop the output sound when the object is obtained in

the game of Akihiro as taught by Subsim Review in order to encourage the player plays the game by an instructing sound."

(See Detailed Action, pg. 4, lines 2-7.)

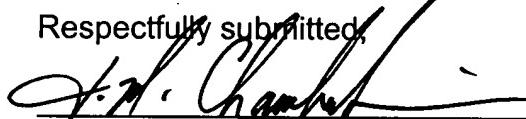
Such motivation is not found within the objective teachings of the cited references. Rather, the stated motivation is only apparent from applicants' disclosure in the present application. But the teaching or suggestion to make the claimed combination must be found in the prior art, and may not be based on the applicant's disclosure. See *In re Vaeck*, 947 F.2d 488, 493 (Fed. Cir. 1991). In the absence of a proper showing of motivation to combine, there is no basis under Section 103 to conclude that it would be obvious for the person of ordinary skill to make the selection and combination of elements required to meet the invention claimed as a whole.

Thus, none of the cited references, either alone or in any combination, disclose, teach or suggest every limitation of claims 1 and 4. Applicant therefore requests that the 35 U.S.C. § 103(a) rejection of these claims be withdrawn and that claims 1 and 4 be allowed. With respect to claims 2 and 3, which depend from claim 1 and recite additional features of the invention, applicant requests that these claims be allowed for the same reasons as indicated for claim 1.

Every effort has been made to present the subject matter of the application in proper form, to particularly and distinctly define the subject matter regarded as the invention and to demonstrate that the subject matter claimed as a whole is properly patentable over the prior art. The claims as amended are believed to be in condition for allowance. Reconsideration and allowance are requested.

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Respectfully submitted,

  
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